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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/519,107  | 12/23/2004  | Yoshiyuki Suzuri     | 04890/HG            | 9443             |
| 1933 7590 11/12/2009<br>FRISHAUF, HOLTZ, GOODMAN & CHICK, PC<br>220 Fifth Avenue<br>16TH Floor<br>NEW YORK, NY 10001-7708 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| YAMNITZKY, MARIE ROSE   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1794  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 11/12/2009  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/519,107

**Applicant(s)**

SUZURI ET AL.

**Examiner**

Marie R. Yamnitzky

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.5,32-36 and 64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1.5,32-36 and 64 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date See Continuation Sheet

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :  
29 July 2005 (modified), 12 Aug 2009.

1. This Office action is in response to applicant's amendment filed July 22, 2009, which amends claims 1, 5, 32 and 33, cancels claims 2-4 and 6-31, and adds claim 64. Although claims 32 and 33 are not marked as amended in the listing of claims filed July 22, 2009, the changes set forth in the listing of claims filed March 11, 2009 (which has not been entered) have been incorporated therein.

The remarks/arguments filed March 11, 2009 and March 23, 2009 have been entered.

The references listed in the IDS filed August 12, 2009 have been considered by the examiner and are made of record.

This Office action is also in response to the terminal disclaimer filed March 11, 2009.

Claims 1, 5, 32-36 and 64 are pending.

2. The terminal disclaimer filed on March 11, 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent No. 7,326,475 has been reviewed and is accepted. The terminal disclaimer has been recorded. Accordingly, the obviousness-type double patenting rejection set forth in the Office action mailed September 22, 2008 is overcome.

3. The rejection under 35 U.S.C. 102(e) based on Iwakuma et al. (US 2004/0086745) as set forth in the Office action mailed September 22, 2008 is partly rendered moot by claim cancellation and otherwise overcome by claim amendment.

The rejection under 35 U.S.C. 102 based on Iwakuma et al. (WO 2003078541) as set forth in the September 22, 2008 action is partly rendered moot by claim cancellation and otherwise overcome by claim amendment. (The examiner also notes that the rejection should have been made under 35 U.S.C. 102(a) instead of 35 U.S.C. 102(c).)

With the exception of the rejection bridging pages 14-19 of the September 22, 2008 action, all rejections under 35 U.S.C. 103(a) as set forth in the action are partly rendered moot by claim cancellation and otherwise overcome by claim amendment.

With respect to the rejection based on Hosokawa in view of Noguchi et al. and Ueda et al. with evidence supplied by Wieczorek et al. (the rejection bridging pages 14-19 of the September 22, 2008 action), the previous examiner considered an electroluminescent device comprising a phosphorescent light emitting layer comprising a compound represented by the second formula on page 19 of the action to be obvious over the combination of references. The compound represented by the second formula on page 19 of the action is a compound within the scope of formula (15) of prior claim 29 and present claim 1, and an electroluminescent device comprising a phosphorescent light emitting layer comprising such a compound would meet the limitations of prior claim 29 and present claim 1. However, the rejection bridging pages 14-19 was not applied against claim 29, and page 39 of the action indicated that claim 29 would allowable if rewritten in independent form, provided the obviousness-type double patenting rejection was overcome. The present examiner has considered the teachings of the references and withdraws the rejection.

4. Claims 1, 5, 32-36 and 64 are allowed.
5. In reviewing the application papers, the examiner noted that some of the entries on the PTO/SB/08 of the IDS filed July 29, 2005 may raise questions during the issue and printing processes. The examiner has made modifications to several citations and includes a copy of the modified PTO/SB/08 with this action.
6. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because of the reasons noted below.

The specification has been amended by three separately filed papers: a one page preliminary amendment filed December 23, 2004 (which amended page 1), an eight page second preliminary amendment filed January 21, 2005 (which amended pages 86-87, 89-90, 115-116, 140, 142-145, 147-148 and 150-151), and a fifteen page amendment filed March 13, 2008 (which amended many of the same pages amended by the second preliminary amendment, and included additional amendments).

Some of the changes set forth in the amendments filed January 21, 2005 and March 13, 2008 are identical, and some of the changes in the March 13, 2008 amendment are inconsistent with the changes made by the January 21, 2005 amendment.

The interlineations or cancellations made in the specification by the various amendments will lead to confusion and/or mistake during the issue and printing processes given the inconsistencies between the amendments filed January 21, 2005 and March 13, 2008.

Accordingly, a substitute specification excluding the claims is required before passing the case to issue.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record (emphasis added; no marked-up copy is required if the substitute specification only incorporates the changes already made). The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

7. This application is in condition for allowance except for the following formal matters:

A substitute specification excluding the claims is required for the reasons noted above.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

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8. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday and Wednesday-Friday.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

/Marie R. Yamnitzky/

Primary Examiner, Art Unit 1794

MRY

November 06, 2009